

REMARKS

I. Summary of Office Action

Claims 1-34 were pending in this application. Claims 3 and 5 were rejected under 35 U.S.C. § 112, second paragraph. Claims 1-4, 6-8, 10-17, 19-21, 23-30, and 32-34 were rejected under 35 U.S.C. § 102(e) as being anticipated by Schein et al. U.S. Patent Application Publication No. 2003/0005445 A1, filed March 16, 2001 (hereinafter "Schein"). Claims 5, 9, 18, 22, and 31 were rejected under 35 U.S.C. § 103(a) as being obvious from Schein.

II. Summary of Applicants' Reply

Applicants have amended independent claims 1, 14 and 27 to make clear that the second area of the screen has both a first display state "and" a second display state. No new matter has been added. The § 102 rejections based on Schein are therefore traversed.

Applicants submit herein a Statement of Common Ownership which removes Schein as prior art with respect to the present application for the purposes of a § 103 rejection. The § 103 rejection should therefore be withdrawn.

Various additional amendments to claims 1, 14, and 27 have been made. Dependent claims 3, 4, 16, 17, 20, 29, 30, and 34 have been amended to correct clerical errors and to align claim language with the antecedent basis set forth in independent claims 1, 14 and 27. No new matter has been added and the amendments are fully supported and justified by the application as originally filed.

New dependent claims 35-37 have been inserted. No new matter has been added and new claims 35-37 are fully supported and justified by the application as originally filed.

Reconsideration and allowance of this application in light of the amendments and following remarks is respectfully requested.

III. The Rejection Under 35 U.S.C. § 112, second paragraph

The Examiner rejected claims 3 and 5 under 35 U.S.C. § 112, second paragraph. In particular, the Examiner contends that the limitation "the third area of screen" of claim 3 lacks antecedent basis. The Examiner rejected claim 5 as being dependent upon claim 3.

In response, applicants have amended claim 3 to recite "the second area of the screen." This feature has antecedent basis in claim 1.

Accordingly, applicants respectfully request that the rejection of claims 3 and 5 under 35 U.S.C. § 112, second paragraph, be withdrawn.

IV. The Rejection Under 35 U.S.C. § 102(e)

The Examiner rejected claims 1-4, 6-8, 10-17, 19-21, 23-30 and 32-34 under 35 U.S.C. § 102(e) as being anticipated by Schein. This rejection is respectfully traversed.

Applicants' independent claims 1, 14 and 27 require "maintaining display" (claims 1 and 14) or "displaying" (claim 27) a television program in an area of a display screen in a first state of the display function and "replacing" the television program in the area of the screen with a second television program represented by a selected television program listing in a second state of the display function. In other words, the two display states for television programs are provided for the same area of a display screen.*

* Applicants' independent claims 1, 14 and 27 and corresponding dependent claims 2-13, 15-26 and 28-34 define additional features of the invention. However, these features will not be

Applicants respectfully submit that the § 102 rejection should be withdrawn for at least the reason that Schein does not disclose "replacing" a "television program" in an area of a display screen with "a second television program represented by a selected television program listing" as required by independent claims 1, 14 and 27. Rather, Schein describes that program guide program area 526 invariably displays the television program viewed by a user before the user entered the program guide (paragraph 133, lines 21-23 and FIG. 16A of Schein). That is, the television program in program area 526 is not replaced with a television program represented by a selected program listing as required by applicants' claims. Schein also describes that preview window area 528, which is separate from program area 526, can be used to display "preview[s]" of television programs, not the television programs themselves (paragraph 133, lines 24-28 and FIG. 16A of Schein). Therefore, this portion of Schein also fails to show applicants' claimed feature of "replacing" a displayed television program

addressed in this Reply because applicants submit that the above described features are sufficient to establish the patentability of applicants' claims over Schein. Applicants reserve the right to further demonstrate the patentability of applicants' claims over Schein at a later stage if necessary.

with a television program represented by a selected program listing.

The § 102 rejection should be withdrawn for at least the additional independent reason that Schein does not disclose providing two display states for television programs for the same area of a display screen as defined in independent claims 1, 17 and 24.

In sum, the foregoing demonstrates that Schein does not disclose all the features of applicants' independent claims 1, 14 and 27. Accordingly, the § 102 rejection of independent claims 1, 14 and 27 and corresponding dependent claims 2-4, 6-8, 10-13, 15-17, 19-21, 23-26, 28-30 and 32-34 should be withdrawn.

V. The Rejection Under 35 U.S.C. § 103(a)

The Examiner rejected claims 5, 9, 18, 22, and 31 under 35 U.S.C. § 103(a) as being obvious from Schein. Pursuant to 35 U.S.C. § 103(c), applicants respectfully submit that the Statement of Common Ownership in the following section removes Schein as prior art with respect to this application for the purposes of a § 103 rejection (see MPEP § 706.02(l)). The § 103

rejection of claims 5, 9, 18, 22, and 31 should therefore be withdrawn.

VI. Statement of Common Ownership

The undersigned hereby states and certifies that:

1) He is an agent of record in the above-identified patent application; and

2) this application and Schein et al. U.S. Patent Application No. 09/810,324, filed March 16, 2001 (Publication No. 2003/0005445 A1) ("Schein"), were, at the time the claimed invention was made, commonly owned by or subject to an obligation of assignment to Gemstar International Group Limited.

In particular, at the time the claimed invention was made: this application was subject to an assignment to E Guide, Inc.;* Schein was subject to an assignment to Starsight Telecast, Inc. by virtue of the assignment attached hereto as Appendix A; and both E Guide, Inc. and Starsight Telecast, Inc. were wholly-owned by Gemstar International Group Limited (see the August 16,

* Thomas E. Ward, III, Kenneth Hancock, and Douglas Macrae are the named inventors on this application. At the time the claimed invention was made, Thomas E. Ward, III, Kenneth Hancock, and Douglas Macrae were obligated to assign the claimed invention to E Guide, Inc. by virtue of their employment with E Guide, Inc.

1995 Acquisition and Exchange Agreement between E Guide, Inc. and Gemstar International Group Limited attached hereto as Appendix B and the May 8, 1997 Merger Agreement between Starsight Telecast, Inc. and Gemstar International Group Limited attached hereto as Appendix C).

VII. Summary of Additional Amendments to Claims 1, 14, and 27

Applicants have further amended independent claims 1, 14 and 27 to specify that "program listings for a plurality of currently-broadcast television programs" are displayed. No new matter has been added.

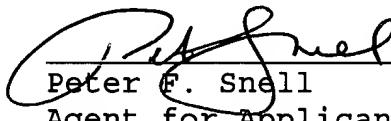
VIII. New Dependent Claims 35-37

New dependent claims 35-37 have been inserted to define additional features of the invention. No new matter has been added and new claims 35-37 are fully supported and justified by the application as originally filed.

IX. Conclusion

Applicants respectfully submit that the foregoing demonstrates that this application is in condition for allowance. Accordingly, prompt consideration and allowance of this application are respectfully requested.

Respectfully submitted,


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